



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,540	12/20/2001	Satoshi Tanioka	50169-223	4907

20277 7590 02/20/2003
MCDERMOTT WILL & EMERY
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096

EXAMINER

SADULA, JENNIFER R

ART UNIT	PAPER NUMBER
----------	--------------

1756

5

DATE MAILED: 02/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/018,540

Applicant(s)

TANIOKA ET AL

Examiner

Jennifer R. Sadula

Art Unit

1756

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 7-22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 12/20/01 has been considered by the examiner. However, the examiner wishes to note that these references merely submitted in Japanese have only been considered on the merits of that which was in English and no more. Any reference without an English language translation, yet cited herein was fully considered on the merits of a translation available to the examiner.

Claim Objections

Claims 1-6 are objected to for failing to be in proper format. A claim must begin with a capital letter and end with a period. Periods may not be used elsewhere in the claims except for abbreviations (MPEP 608.01(m) and also see *Fressola v. Manbeck*, 36 USPQ2d 1211 (D.D.C. 1995). Claim 1 fails to comply with this rule.

Claims 7-22 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from another multiply dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

Double Patenting

Claims 1-6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-20 of copending Application No. 10/019,260. Although the conflicting claims are not identical, they are not

Application/Control Number: 10/018,540

Art Unit: 1756

patentably distinct from each other because the breadth of one each set of claims encompasses that which the Applicants are attempting to cover- thereby creating duplication.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. This double patenting rejection may apply to claims 7-22 after such claims are properly connected to the parent claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Shimizu, U.S.

Patent No. 5,907,005.

Shimizu teaches a varnish composition comprising polyamic acid components as specified in column 3, lines 50-59 and/or a soluble polyimide as specified. For purposes of this rejection, the Examiner has interpreted the polyimide to be present in Shimizu, however, Shimizu further teaches that it is also possible to apply the patented invention to a varnish of polyamic acid having the polyamic acid partially changed to imide (5:34-36). The concentration of polyamides is suitably 0.1 to 40%, thereby encompassing Applicants claims 2-3 and 5-6. Shimizu further teaches that the materials be tetracarboxylic dianhydrides as mentioned in column 4.

Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Kimura et al., U.S. Patent No. 5,783,656, ("Kimura").

Kimura teaches polyamic acid polyimide liquid crystal alignment agents wherein the polyamic acids are obtainable by reacting diamine compounds of formula 1 with tetracarboxylic acid dianhydrides and the polyimides are obtainable by dehydration and subsequent ring closure of the polyamic acid (abstract). The specified materials are thus noted in formulas 22 and 23 wherein the examples all prove to be within the boundaries as set forth in Applicants claims 2-3 for concentrations.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer R. Sadula whose telephone number is 703.305.4835. The examiner can normally be reached on Monday through Friday, 10am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark F. Huff can be reached on 703.308.2464. The fax phone numbers for the organization where this application or proceeding is assigned are 703.872.9310 for regular communications and 703.872.9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.0661.

JRS
February 10, 2003


MARK F. HUFF
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700